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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,547	06/05/2001	Dan Kikinis	ISURFTV139	6896

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EXAMINER
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SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/875,547

Applicant(s)

KIKINIS, DAN

Examiner

Dominic D. Saltarelli

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 16, 2006 has been entered.

***Response to Arguments***

2. Applicant's arguments filed March 16, 2006 have been fully considered but they are not persuasive.

First, applicant argues that Hassell only discloses digital storage and says nothing about a removable storage device (applicant's remarks, page 6, lines 7-10).

In response, Hassell makes several references to storing data on removable storage devices, including removable video cassettes and recordable DVD discs (see paragraphs 8 and 20).

Second, applicant argues that Hassell does not disclose a single actuation (applicant's remarks, page 6, lines 10-11).

In response, it is paragraph 81 which is cited by Hassell, which teaches the actuation of a "transfer" key on a remote control initiates a transfer of program content from one volume to another.

Third, applicant argues that Hassell does not disclose the actuation does not require the use of any menus or options (applicant's remarks, page 6, lines 11-12).

In response, as stated above, the single actuation taught by Hassell is pressing a physical button on a remote control, and the use of a transfer option selected from a menu is an alternative embodiment (see Hassell, paragraph 81).

Lastly, regarding applicant's argument regarding the 35 U.S.C. 103(a) rejections of claims 2, 9, and 16, said arguments are moot in view of the new grounds of rejection set forth herein.

### ***Claim Objections***

3. Claim 14 is objected to because of the following informalities: Line 1 reads "removal n e storage" and should be changed to --removable storage--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

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4. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The newly added limitations of transferring the program and auxiliary data to the removable storage device without requiring the use of options is not enabling the because the very feature of saving said contents to a removable storage device is an optional feature (see paragraphs 0026 and 0027 of applicant's own disclosure). If the user were not provided with the option of storing the program and auxiliary data in the removable storage device, then it would never happen.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-8, 10-15, and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell et al. (US 2004/0128685 A1, of record) [Hassell].

Regarding claims 1, 8, and 15, Hassell discloses a method (and corresponding system) comprising:

displaying an electronic programming guide on a display (figs. 5a-b);  
receiving a single actuation from a user by an entertainment system and  
transferring a program (paragraphs 40-42) and auxiliary data (paragraphs 52-53)  
related to the program from a first storage device of the STB to a removable  
storage device (see the last sentence of paragraph 9) in response to the single  
actuation and without requiring the use of menus or options (paragraphs 19-21,  
and 81).

Regarding claims 3, 10, and 17, Hassell discloses the method, machine  
readable medium, and system of claims 1, 8, and 15, wherein the single  
actuation includes a single pressing of a selected portion on a remote control  
apparatus (see paragraph 81, actuation of the "transfer" key on the remote  
control is all that is necessary to record a highlighted or active program).

Regarding claims 4, 11, and 18, Hassell discloses the method, machine  
readable medium, and system of claims 1, 8, and 15, wherein in response to a  
single actuation from the user, transferring a program and auxiliary data related  
to the program from the removable storage device to the first storage device of  
the STB (see paragraphs 9 and 81, wherein Hassell anticipates the transfer of  
data from one volume of storage to another [primary to secondary and vice  
versa] simply by pressing a "transfer" key on a remote control).

Regarding claims 5, 12, and 19, Hassell discloses the method, machine readable medium, and system of claims 4, 11, and 18, and further discloses maintaining an index of programs and related auxiliary data transferred from the first storage device to the removable storage device (paragraphs 85-86).

Regarding claims 6, 13, and 20, Hassell discloses the method, machine readable medium, and system of claims 5, 12, and 19, wherein in response to a user selecting a program transferred on to the removable storage device, the STB prompts the user to insert the removable storage device into the STB (paragraph 89).

Regarding claims 7, 14, and 21, Hassell disclose the method, machine readable medium, and system of claims 6, 14, and 20, wherein the removable storage device is a DVD-RAM (paragraph 20).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell.

Regarding claims 2, 9, and 16, Hassell discloses the method, machine readable medium, and system of claims 1, 8, and 15, but fails to disclose the single actuation includes a single pressing of a selected portion on a control panel of the STB.

Examiner takes official notice that it is notoriously well known in the art to provide set top boxes with control panels that have many of the same buttons and functionality of an associated remote control, as remote controls can be easily lost and a corresponding control panel allows a user to continue to use a set top box even without the remote control.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method, machine readable medium, and system disclosed by Hassell to include on the STB a control panel with the same buttons for actuation as is provided on the associated remote control, and would thus include the disclosed "transfer" key as found on the remote control disclosed by Hassell, providing the benefit of allowing a user to continue using the features of which the STB is capable even if the remote control is lost or misplaced.

### ***Conclusion***

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.



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## Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
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